

REMARKS

By this Amendment, Applicant amends claims 1, 4, 5, 9, 12, 17, 21, 24, 27, 31, 33, and 34. Claims 1, 4, 5, 8, 9, 12, 14-21, 23, 24, and 26-34 remain pending in this application.

In the Final Office Action,¹ the Examiner took the following actions:

rejected claims 1, 4, 5, 9, 12, 14, 15, 17, 18, 21, 24, 27, 28, 31, 33, and 34 under 35 U.S.C. § 103(a)² as being unpatentable over Bull et al. (U.S. Patent No. 5,995,943) in view of Rodkin et al. (U.S. Patent No. 6,092,074); and

rejected claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Kirsch et al. (U.S. Patent No. 6,189,030).

I. Telephonic Interview of February 9, 2009

Applicant thanks the Examiner for discussing the present application with Applicant's representative during the telephonic interview of February 9, 2009. During the interview, the pending independent claims were discussed in relation to the Rodkin reference.

In the Advisory Action mailed February 13, 2009, the Examiner indicated that the proposed amendments in the Amendment After Final of February 2, 2009, would be entered and that "the proposed amendment overcomes paragraph 7 of the Office action mailed 31 October 2008." Advisory Action, continuation sheet. Paragraph 7 of the

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

² Although the caption of the rejection states that the ground of rejection is under 35 U.S.C. § 102(e), based on the substance of the rejection, Applicant believes the rejection was intended under 35 U.S.C. § 103(a).

Final Office Action had alleged that “no patentable weight” was given to certain claim elements that the Examiner characterized as “optional.” See Final Office Action at page 3. However, the Advisory Action further indicated that the rejections of the claims would not be withdrawn “because of the special meaning of ‘code’ in para. 5 of the 31 Oct 2008 office action.” Id. In particular, the Examiner contends that the claimed “[c]ode is interpreted to be the reference ‘hypertext links’.” Id. In the supplemental Office communication mailed February 11, 2009, the Examiner clarified that “the examiner failed to note that the rejection of record can be overcome by amending the claims so as to replace ‘advertiser-chosen word’ . . . with -- advertiser-chosen human-language word --”. Supplemental Office communication, page 2.

Although Applicant respectfully disagrees with the Examiner’s contentions and believe that the claims, as proposed to be amended in the Amendment After Final of February 2, 2009, distinguish over the applied references, in an effort to expedite prosecution, Applicant has further amended the claims according to the Examiner’s suggestion. Specifically, the pending claims have been amended to replace “advertiser-chosen word” with “advertiser-chosen human-language word” (emphasis added). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections.

II. Rejections of Claims under § 103(a)

Applicant respectfully traverses the rejection of claims 1, 4, 5, 9, 12, 14, 15, 17, 18, 21, 24, 27, 28, 31, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over

Bull in view of Rodkin et al. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements. M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Independent claim 1, as amended, recites an apparatus for hyperlinking specific words in content to convert the words into advertisements including, among other things, "code" in a content file that:

(1) "references said ad server to determine at least one existing advertiser-chosen human-language word present in said content file"

and

(2) "said code automatically, as said content file is interpreted by said web browser, providing a hypertext anchor for said at least one existing advertiser-chosen human-language word, thereby converting said at least one existing advertiser-chosen human-language word into an advertisement by linking said at least one advertiser-chosen human-language word to said advertiser web page"

(emphasis added).

The cited references do not teach or suggest at least these elements of independent claim 1.

Bull discloses that pre-prepared ads are inserted into a web page. For example, Fig. 6 of Bull shows an arrow labeled "GET AD TO INSERT," indicating that an ad is retrieved from advertising database 250. After retrieving the ad, the Bull system will then "cause an advertisement/coupon to be added into the display." See col. 12, lines 15-16. While Bull teaches that page content in the form of an ad is added, Bull does not teach or suggest Applicant's claimed "code" in a content file that "references said ad server to determine at least one existing advertiser-chosen human-language word present in said content file" and "as said content file is interpreted by said web browser, provid[es] a hypertext anchor for said at least one existing advertiser-chosen human-language word, thereby converting said at least one existing advertiser-chosen human-language word into an advertisement by linking said at least one advertiser-chosen human-language word to said advertiser web page," as recited in independent claim 1 (emphasis added).

Rodkin discloses:

The character strings from the annotation database, i.e., the strings which are searched, can therefore be used by annotator software of the Intelligent AnnotatorTM 520 to automatically build a DFA whose terminal states indicate that a matching character string from the annotation database 535 has been found in the article to be annotated 405. Once a matching character string is found, the Intelligent AnnotatorTM 520 provides an anchor code which references a destination address in the destination and expiration database 540.

...
The Intelligent AnnotatorTM traverses the text of the article. That is, each word or phrase is examined to determine

whether the text should be converted to hypertext. Moreover, for words or phrases which already have conventional hypertext anchors, the new anchor data in accordance with the present invention can either overwrite the old anchor data, or be inserted along with the old anchor data. Therefore, the article to be annotated 405 may be a text file with no hyperlinks, or a file with conventional hyperlinks. Additionally, as mentioned, the article to be annotated need not be a discrete file, but may comprise computer information from any source, and in any format.

Rodkin, col. 15, lines 8-17 and 36-47.

As set forth above, the Intelligent Annotator 520 of Rodkin determines whether to convert text to hypertext. Specifically, as shown in, for example, Figure 5 of Rodkin, the Intelligent Annotator 520 is a component of content server 410. Accordingly, Rodkin discloses a content server that uses the Intelligent Annotator to convert text to hypertext at the content server. However, the Intelligent Annotator in Rodkin does not constitute or suggest Applicant's claimed "code." Rather, the Intelligent Annotator in Rodkin converts text to hypertext at content server 410, but Rodkin does not teach or suggest Applicant's claimed "code" in a content file that (1) "references said ad server to determine at least one existing advertiser-chosen human-language word present in said content file" and (2) "as said content file is interpreted by said web browser, provid[es] a hypertext anchor for said at least one existing advertiser-chosen human-language word, thereby converting said at least one existing advertiser-chosen human-language word into an advertisement by linking said at least one advertiser-chosen human-language word to said advertiser web page," as recited in independent claim 1 (emphasis added).

As explained above, the elements of independent claim 1 are neither taught nor suggested by the cited references. Moreover, there is no teaching in the cited references that would motivate one of ordinary skill in the art to modify the disclosures

thereof to achieve the claimed combination. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and independent claim 1. Accordingly, no reason has been clearly articulated as to why independent claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a).

Independent claims 9, 17, 21, 24, 27, 31, 33, and 34, although of a different scope from independent claim 1 and each other, include recitations similar to those discussed above in connection with independent claim 1. Accordingly, a *prima facie* case of obviousness has not been established for independent claims 9, 17, 21, 24, 27, 31, 33, and 34 for at least the reasons discussed above. Furthermore, claims 4, 5, 12, 14, 15, 18, and 28 are allowable at least due to their dependence from the independent claims. Therefore, the Examiner should also withdraw the rejection of claims 1, 4, 5, 9, 12, 14, 15, 17, 18, 21, 24, 27, 28, 31, 33, and 34 under 35 U.S.C. § 103(a).

Independent claim 31 further recites “positioning a mouse pointer over the hyperlink, the positioning causing a description of the advertiser web page to be displayed.” The Final Office Action admits that “Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink” (emphases in original). See page 4. The Examiner then alleges that principles of inherency make up for this admitted deficiency of Bull. Applicant disagrees.

MPEP § 2112.02 explains that, “[u]nder the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process.” See MPEP § 2112.02, citing *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). The Final Office Action cites a portion of Bull that “teaches clicking on a URL … to access a Web page.” See page 4. Regarding this teaching, the Office Action further alleges that “[t]he mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.” However, positioning a mouse pointer over a URL link in order to click on the link does not constitute “positioning a mouse pointer over the hyperlink, the positioning causing a description of the advertiser web page to be displayed,” as recited in claim 31 (emphasis added).

Moreover, the principles of inherency do not apply in the present instance, because nothing in Bull indicates that it would “necessarily perform the method claimed,” as required by MPEP § 2112.02. Instead, Bull only discloses clicking a URL, but does not teach “positioning a mouse pointer over the hyperlink, the positioning causing a description of the advertiser web page to be displayed,” as recited in claim 31 (emphasis added).

The Final Office Action further alleges that “said web page itself reading on a ‘description of the advertiser web page.’” Final Office Action at page 5. This is incorrect for at least two reasons. First, Applicant’s claim 31 recites displaying a “description,”

not displaying the web page itself. Second, the Final Office Action ignores that it is the “positioning [of] a mouse pointer over the hyperlink” that causes the description to be displayed, not clicking on a link. Moreover, Rodkin does not compensate for these deficiencies of Bull. Accordingly, the rejection of independent claim 31 is improper for at least these additional reasons.

Applicant respectfully traverses the rejection of claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Bull in view of Rodkin and in further view of Kirsch. A *prima facie* case of obviousness has not been established.

As discussed above, Bull and Rodkin do not teach or suggest all of the elements of independent claims 1, 9, 17, 21, 24, 27, and 31, from which claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 depend. Furthermore, Kirsch does not compensate for the deficiencies of Bull and Rodkin and, accordingly, the elements of the claims are neither taught nor suggested by the cited references at least due to their dependence. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claims 8, 16, 19, 20, 23, 26, 29, 30, and 32 and the Examiner should withdraw the rejection of the claims under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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